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DEC 15 2004

In re Application of	:	OFFICE OF PETITIONS
Raman et al.	:	
Application No. 10/019,634	:	DECISION DISMISSING
Filed: December 27, 2001	:	PETITION
Attorney Docket No. 60556-303620	:	

This is a decision on the petition under 37 CFR 1.137(a), filed September 13, 2004, to revive the above-identified application.

This application became abandoned for failure to reply timely to the final Office action mailed February 20, 2004, which set a three-month shortened statutory period to respond. Applicants did not timely and properly obtain any extensions of time to respond under 37 CFR 1.136(a). Accordingly, this application became abandoned on May 21, 2004. The present petition precedes the mailing of a Notice of Abandonment.

In the present petition, Daniel B. Schein, attorney for applicants, asserts that delay in filing the response was unavoidable because his illness and hospitalization prevented him from completing the preparation and filing of the reply until after the due date. Specifically, Dr. Schein explains that he began to suffer flu-like symptoms on August 16, 2004, and did limited work on August 17, 18, and 19, 2004. However, on August 19, 2004, his illness worsened and he sought treatment at O'Connor Hospital in San Jose, California. Dr. Schein was discharged from the hospital on August 21, 2004. A copy of the Nursing Discharge Summary Instructions are enclosed with the petition. Dr. Schein contends that his hospitalization rendered him incapable of filing a timely reply to the final Office action mailed February 20, 2004.

On petition, applicants also submitted, *inter alia*, payment of the requisite fees, a request for a three-month extension to

respond, and a reply to the Office action in the form of an RCE and an amendment.

DISCUSSION

A grantable petition under 37 CFR 1.137(a) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(l); (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c). The present petition lacks item (3).

The showing of record before the Office is inadequate to establish unavoidable delay within the meaning of 37 CFR 1.137(a)(3).

Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable (The word 'unavoidable' ... is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business.) In re Mattullath, 38 App. D.C. 497, 514-15 (1912) (quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 U.S.P.Q. 666, 167-68 (D.D.C. 1963), aff'd, 143 U.S.P.Q. 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913). Decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith, 671 F.2d at 538, 213 U.S.P.Q. at 982. Nonetheless, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines, 673 F. Supp. at 316-17, 5 U.S.P.Q.2d at 1131-32.

Applicants must show to the satisfaction of the Commissioner that the entire delay in filing the required reply **from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable**. Applicants did not obtain any proper and timely extensions of time to respond. Accordingly, the due date for the reply was on May 20, 2004. Dr. Schein asserts incapacitation due to his illness and hospitalization from August 19, 2004 to August 21, 2004. However, Dr. Schein has failed to show why he was unavoidably

delayed from filing the reply from the due date of May 20, 2004, to the time of his illness.

Additionally, Dr. Schein has failed to show what steps were taken during his hospitalization to seek the assistance of another member of the law firm to timely file the reply with a request for a three-month extension of time to respond in his absence.

Applicants have not provided a sufficient showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply (May 20, 2004) until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable.

The Office notes that an applicant may delay action until the end of the time period for reply. However, in doing so, the applicant must assume the risk attendant to such delay. See Ex parte Warren, 1901 Dec. Comm'r Pat. 137 (Comm'r Pat. 1901).

CONCLUSION

The showing required under 37 CFR 1.137(a) is exacting, and applicants have not met that showing.

Accordingly, the petition must be **DISMISSED**.

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from the mail date of this decision. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(a)" or "Petition under 37 CFR 1.137(b)," as appropriate. Extensions of time are permitted under 37 CFR 1.136(a).

Alternative Venue

While the showing of record is not sufficient to establish to the satisfaction of the Commissioner that the delay was unavoidable, applicants are not precluded from seeking relief by filing a petition under 37 CFR 1.137(b) on the basis of unintentional delay. A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) the reply required to the outstanding Office action or notice, unless previously filed; (2) the petition fee as set forth in 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional; and (4) any terminal disclaimer (and fee as set forth in 1.20(d)) required pursuant to 37 CFR 1.137(d).

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX: (703) 872-9306
Attn: Office of Petitions

By hand: U.S. Patent and Trademark Office
220 20th Street S.
Customer Window, Mail Stop Petition
Crystal Plaza Two, Lobby, Room 1B03
Arlington, VA 22202

Pursuant to 37 CFR 1.136, an extension of time must be filed prior to the expiration of the maximum period obtainable for reply to avoid abandonment. Accordingly, applicants may request a refund of the \$950.00 extension of time fee submitted on September 13, 2004, because it was submitted subsequent to the maximum period obtainable for reply. Applicants may request a refund of the \$950.00 fee by writing to the following address:

Mail Stop 16
Director of the US Patent and Trademark Office
PO Box 1450
Alexandria, VA 22313-1450

A copy of this decision should accompany applicants' request.

Telephone inquiries related to this decision should be directed to the undersigned at (571) 272-3211.

Christina Tartera Donnell

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Office of Petitions